

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/785,969

Filing Date: February 17, 2001

Title: METHOD AND APPARATUS FOR ACCESSING AND STORING DIGITAL IMAGES

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Remarks

Claims 1-5 and 7-37 are pending.

Claims 1-3, 7-10, 13-16, 18, 24-28, and 33-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324). The rejections are all based on the assertion that Altman teaches printing (1) a sales receipt for a financial transaction and (2) the sales receipt includes a thumbnail of the digital image(s) involved in the transaction. This assertion is not correct.

Claim 1 -- Printing A Sales Receipt That Includes A Thumbnail

Claim 1 recites "performing a financial transaction for storing at least one digital image ... and printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image...." In support of the rejection of Claim 1, the Office states that "Altman teaches a printer 86 that can transmit receipts of electronic documents as thumbnail views or blow-up [sic] views to confirm storage as claimed (page 6, [0088], lines 1-6, figs. 2 and 3)." Office Action, page 4. The passage in Altman cited by the Office states that printer 86 is used "for the production of physical documents. These physical documents include labels ... as well as read-outs of logical sets of records that are retrieved from electronic storage 108." Altman, paragraph [0088]. Conspicuously absent from this passage in Altman is any mention of printer 86 printing a sales receipt, specifically not a sales receipt of electronic documents as thumbnail views.

The fact is that Altman does not teach printing a sales receipt of any kind. Indeed, Altman does not even teach performing a financial transaction for storing a digital image for which a sales receipt might be printed. The Office all but admits that Altman does not teach these claim elements at page 10 of the Office Action. Rather, the Office argues:

"All one has to do is to print the document using the computer system of Altman and that would be considered as a receipt for the transaction as claimed. Altman teaches a workstation 106 that can present the electronic image documents and the electronic work documents as thumbnail views or blow-ups views [sic]; the workstation is operatively connected to printer 86 for transmission and receipt from the printer of control signals for the production of physical documents. Altman teaches about having retail and wholesale customer number and it is appropriate to say that Altman would need to print receipt [sic] of the transaction for the customers using the printer 86." Office Action, page 10.

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There is absolutely no evidence at all supporting the Office's assertion that printing a thumbnail image alone somehow equates to printing a sales receipt that includes thumbnail image. The fact is that the Office is speculating when it says that printing a thumbnail image "would be considered" printing a sales receipt, but offers no proof that printing a thumbnail image without more is equivalent to printing a sales receipt. The Office speculates again when it asserts that "it is appropriate to say" that Altman would need to a print receipt of the transaction for the customers using the printer 86, but offers no proof. Altman does not even teach a customer using printer 86. The reference to a "retail and wholesale customer number" in Altman is directed to one possible entry for the Official No data field in the File Table designated part no. 66 in Altman Fig. 9. This customer number doesn't suggest "customers using printers 86." In any event, the fact that a "customer" might use printer 86 in Altman does nothing to suggest performing a financial transaction for storing a digital image at a remote site or printing a sales receipt for any such transaction. To the extent the Office has somehow taken Official Notice that it is common knowledge that printing a thumbnail image is equivalent to printing a sales receipt that includes a thumbnail image, then the Applicant requests that the Office prove up the Official Notice because, so far as Applicants are aware, this broad generalization is not common knowledge (it's not even true). See MPEP § 2144.03(C).

With all due respect, the Office can't simply make things up to support a rejection. Claim 1 should be allowed unless the Office can provide a reference that teaches printing a sales receipt that includes a thumbnail image in a field closely related to financial transactions for storing digital camera images at a remote site. Altman clearly is not such a reference.

Claim 15 is a means plus function counterpart to method Claim 1 and contains similar limitations. For these same reasons, therefore, the rejection of Claim 15 should also be withdrawn.

For these same reasons, Claims 2, 3, 7-10, 33 and 34 which depend from Claim 1 should be with allowed.

Claim 13 -- Confirming Storage With A Receipt

Claim 13 recites conducting a financial transaction for storing a digital image at a remote site and confirming storage of the image at the remote site with a receipt. The Office does not specifically address the receipt limitations of Claim 13 apart from the remarks noted above for

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Claim 1. See Office Action, page 4. As detailed above, Altman does not teach confirming any kind of image storage transaction with a receipt. Altman does not even teach performing a financial transaction for storing a digital image that might be confirmed with a receipt. Consequently, the rejection of Claim 13 and Claim 14 depending from Claim 13 should be withdrawn.

Further with regard to Claim 14, Altman does not teach or suggest printing a sales receipt of any kind, and specifically not a sales receipt that includes identifying information related to the stored digital image.

Claim 19 -- Point of Sale Financial Transaction and Sending Images From User's Camera

Claim 19 recites

...a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site...

As discussed in the Response to the prior action, neither the Parulski, Bidun or Altman references teach or suggest sending digital images from a user's digital camera to a remote storage site. As a result, a combination of these references does not yield the missing element. In addition, there is no processor programmed to perform a point-of-sale transaction for sending the digital images from a user's digital camera. The Bidun reference also teaches away from the invention as claimed, as it touts the advantages of being free of a camera and other equipment related to the camera. The teaching away of the Bidun reference is evidence of the lack of a suggestion or motivation to combine or modify the prior art to yield the claimed combination. In fact, Bidun, arguably, may not be properly combinable with the other references because of the teaching, since combining the reference would destroy the purpose of the reference. Accordingly, Claim 19 distinguishes patentably over the cited references as do Claims 20-21 depending from Claim 19.

Claim 24 -- Determining Price and Confirming Storage

Claim 24 recites a program for instructing a processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, send paid-for digital images to the remote site. The Office not specifically address

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the limitations in Claim 24. The Office makes some vague assertions at page 6 of the Action about a computer program to "determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site...." These assertions are not supported by citation to any reference. Furthermore, the Office's discussion of method Claim 1 does not address the pricing and payment limitations in Claim 24. The Office has, therefore, completely failed to establish a prima facie case of obviousness as to Claim 24 and 25-32 depending from Claim 24.

Claims 4, 5, 17, 22, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Bidun and further in view of www.telepix.com. The Office asserts that www.telepix.com teaches printing a receipt. Claims 4-5, 17 and 22-23 are all dependent claims. It is not clear if the Office intends the combination of Parulski, Bidun and telepix as an independent grounds for rejecting the base claims too, or if the Office mistakenly failed to also cite to Altman, as in the rejection of the base claims. In any event, the only discussion of a receipt in telepix appears to be on page 3 of the reference, marked 2X. There is no further discussion of printing a receipt or a discussion detailing the form of the receipt in the www.telepix.com reference (2X). In fact, there is some question as to whether the receipt is a sales receipt. Claims 4 and 5 depend from Claim 1 which recites "...printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image." There is no mention of this complete element in telepix.

Claim 17 depends from Claim 15. Claim 17 includes the elements of Claim 15 which recites "...means for printing sales receipts for the transactions that include information identifying the stored images, the identifying information including thumbnail images of the stored digital images". Again, there is no mention of this complete element in telepix.

Claim 22 depends from Claim 19. Claim 22 includes the elements of Claim 19 which recites

...a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site...

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Claim 22 also adds "...a receipt printer coupled to the processor; whereby the processor can command the printer to print out receipts of the transactions." Claim 23 depends from Claim 22 and adds that the processor commands the printer to print receipts including thumbnails of paid for images. The complete recitations included in Claim 22 (and Claim 19) are not taught in the references. Accordingly, since the combination of references falls short of the claim language, the claims overcome the Office's rejection under 35 USC § 103(a).

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Bidun as applied to Claims 1 and 11 and further in view of Eastman Kodak ("Kodak to acquire 51% stake in Picture Vision", M2 Presswire, February 13, 1998, pg. 1). It is not clear if the Office intends the combination of Parulski, Bidun and Kodak as an independent grounds for rejecting the base claims too, or if the Office mistakenly failed to also cite to Altman, as in the rejection of the base claims. Claim 12 depends indirectly from Claim 1, which recites "...printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image..." The Office admits that neither the Parulski reference or Bidun reference teaches printing a receipt. Kodak also does not teach printing a receipt as claimed and the Office makes no specific assertion to the contrary. As a result, the Office fails to make out a prima facie case of obviousness and the rejection of Claim 12 should be withdrawn.

The foregoing is believed to be a complete response to the pending office action.

Respectfully submitted,

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